

## REMARKS

Claims 1-8 were examined. Claims 1-4 were rejected. In response to the above-identified Office Action, Applicants do not amend, add, or cancel any claims.

Reconsideration of the rejected claims in light of the following remarks is requested.

### I. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,700,809 issued to Ng *et al.* ("Ng"), U.S. Patent No. 6,691,252 issued to Hughes *et al.* ("Hughes") and U.S. Patent No. 5,740,098 issued to Adams *et al.* ("Adams"). For the reasons discussed below, Applicants believe that these rejections are improper.

As to claim 1, that claim recites a method comprising using a plurality of cells of a content addressable memory (CAM) array as a decoder and algorithmically testing a second plurality of cells of the array based on addresses provided by the first plurality. The Examiner rejected claim 1 based on allegedly similar methods taught by Ng, Hughes, and Adams.

Regarding the Ng method, Applicants note that memory array 201 is specifically described as *not* including compare circuits, so that memory cannot be content-addressable. (*See Ng col. 10, lines 48-51.*) Therefore, it is irrelevant that addresses can be fed from Ng's HASH index generator 131 to memory array 201 for testing the memory array, since no testing of CAM array cells is accomplished. Claim 1 requires testing of a second plurality of cells of the CAM array. The cells of the second plurality are content-addressable, while the storage elements within Ng's memory array 201 are not.

Similarly, regarding the Hughes method, Applicants observe that the CAM is used to store the addresses of defective memory cells. However, the memory cells themselves are normal RAM (SRAM or DRAM), accessed by address and not by content. Thus, in Hughes, the CAM is not used to provide addresses to test a second plurality of CAM cells, as claim 1 requires.

Regarding the Adams method, Applicants point out that the CAM operates in conjunction with a data cache unit (DCU), which is not itself a CAM. Thus, although the CAM is involved in testing the DCU, it is not involved in testing a CAM. In fact, Adams mentions a completely separate method of testing the CAM (*see Adams at col. 6, lines 13-20*) that does not involve a first plurality of CAM cells providing addresses for testing a second plurality of CAM cells.

Thus, Applicants respectfully submit that each of the references provided fails to teach testing a second plurality of cells of the array based on addresses provided by the first plurality. The Examiner is requested to withdraw the rejection of claim 1.

As to claims 2 and 3, those claims depend upon claim 1, which was shown to be patentable over the references of record in the preceding discussion. For at least the reasons discussed above, Applicants respectfully request that the Examiner withdraw the rejections of these claims.

## **II. Claims Rejected under 35 U.S.C. § 101**

The Examiner rejected claim 1 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1, 4, 5 and 6 of U.S. Patent No. 6,744,655 issued to Applicants. Statutory double patenting under § 101 requires that the claims claim the “same invention.” This means that the subject matter of the claims must be identical. See MPEP § 804-II Requirements of a Double Patenting Rejection, second paragraph. The Examiner’s response observes that “claim 1 of this instant application contains identical language as included in claims 1, 4, 5, and 6 of the [‘655] patent” is present. However, claims 1, 4, 5 and 6 of the ‘655 patent each include an additional element not present in claim 1 of the instant application. Therefore, Applicants respectfully submit that the instant claim 1 does not have identical subject matter as claims 1, 4, 5 and 6 of the ‘655 patent. Accordingly, the rejection based on statutory double patenting should be withdrawn.

## **III. Claims Rejected Under Non-Statutory Double Patenting**

The Examiner rejected claims 1, 2 and 4 as unpatentable over claim 7 of the ‘655 patent to Applicants, mentioned above. Applicants traverse this rejection by means of the terminal disclaimer filed herewith.

## **IV. Allowable Material**

Applicants note with appreciation that the Examiner indicated that the remaining claims, claims 5-8, contain allowable material.

## CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-8, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

Dated: 12/3 2004

Respectfully submitted,  
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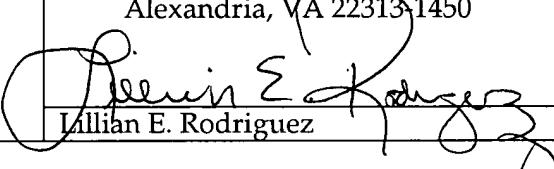
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